

Serial No. 09/771,425

**REMARKS**

The Final Office Action of September 29, 2003, and the Advisory Action of February 13, 2004, have been received and reviewed. Claims 1-11, 14-16, 18, and 21-25 are pending in the application and all pending claims stand rejected. Applicants propose to amend claims 1, 3-11, 14, 15 and 21-25 as set forth herein. In the event the proposed amendments are entered, applicants will also cancel claim 2. All proposed amendments and cancellations are made without prejudice or disclaimer. Reconsideration is respectfully requested.

**Information Disclosure Statement**

Applicants would like to thank the Examiner for considering the Information Disclosure Statement submitted on December 4, 2003.

**Rejections under 35 U.S.C. § 112, second paragraph**

Claims 11, 15-18, 24 and 25 stand rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite. Applicants respectfully traverse the rejections as set forth herein.

In the event the proposed amendments are not entered, applicants reserve the right to re-instate any arguments presented in previous communications to the Office.

Applicants note that the Advisory Action indicated that "if the amendment were entered, the rejection of claim 11 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph would be overcome." (Advisory Action of February 13, 2004, page 2).

With regard to claim 15, the Advisory Action indicated that "a step of measuring binding of a compound being to the orphan receptor should be added if there is support in the specification." (*Id.*). Although applicants do not agree that claim 15 is indefinite, applicants propose to amend claim 15 in accordance with the suggestion of the examiner to recite in part "measuring binding of a ligand to the chimeric receptor." Support for the proposed amendment to claim 15 is found, *inter alia*, at paragraphs [0018] and [0091] of the as-filed specification. (See, Specification, as-filed, paragraphs [0018] and [0091]). Thus, claim 15 should be definite.

Indefinite rejections of record were maintained since it was thought "the claims are indefinite because the steps recited by the methods do not necessarily achieve the goal set forth in

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the preamble." (Final Office Action at page 2). The Final Office Action stated "the method steps never require measuring and/or comparing the binding of a ligand to a chimeric receptor in the presence or absence of a test compound" (*Id.* at page 3) and the Advisory Action indicated that "activation or deactivation of the reporter system is not an indicator of whether a compound (an antagonist) binds to a chimeric receptor." (Advisory Action at page 2). Although applicants do not agree with the rejections, to expedite prosecution, applicants propose to amend claims 24 and 25 as set forth herein.

Applicants propose to amend each of claims 24 and 25 to recite in part "comparing the inhibiting activity of said series of compounds to a positive or a negative control." Support for the proposed amendments are found, *inter alia*, at paragraphs [00105] and [00112] of the as-filed specification. (See, Specification, as-filed, paragraphs [00105] and [00112]). Since the proposed amendments adopt suggestions of the Examiner in the Final Office indicating that "the method steps never require measuring and/or comparing the binding of a ligand to a chimeric receptor in the presence or absence of a test compound," the proposed amendments to claims 24 and 25 should be entered. (Final Office Action at page 3).

Reconsideration and withdrawal of the indefiniteness rejections of claims 11, 15-18, 24 and 25 are requested.

### Rejections under 35 U.S.C. § 103

Claims 1-6, 10, 11, 14-16, 18 and 21-25 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Pestka *et al.* in view of Trueheart *et al.* Applicants respectfully traverse the rejections as set forth herein.

In the event the proposed amendments are not entered, applicants reserve the right to reinstate any arguments presented in previous communications to the Office.

A *prima facie* case of obviousness cannot be established with regard to any of independent claims 1, 15, 24 or 25 as proposed to be amended, since the cited references do not, alone or in combination, teach or suggest each and every element of any of the independent claims. For instance, the asserted combination of the chimeric receptor of Pestka *et al.* with the

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yeast cells of Trueheart *et al.* do not result in the mammalian cells of any of independent claims 1, 15, 25 or 25.

Further, no suggestion or motivation exists to combine the cited references since one of ordinary skill in the art would not be motivated to combine the chimeric receptor of Pestka *et al.* with the yeast cells of Trueheart *et al.* However, in order to expedite prosecution, applicants propose to amend each of independent claims 1, 15, 24 or 25 as set forth herein.

As proposed to be amended, each of independent claims 1, 15, 24 and 25 is directed to a **mammalian cell**, and not to **any eukaryotic cell**. Since each of the working examples of Trueheart *et al.* is limited to the use of yeast cells, one skilled in the art would not reasonably expect the chimeric receptor of Pestka *et al.* to function in the yeast cells of Trueheart *et al.* Since the receptors of Trueheart *et al.* are functionally integrated in the signaling pathway, *e.g.*, the endogenous signaling pathway (See, Trueheart *et al.*, page 16, line 26 through page 17, line 1) of the yeast cells of Trueheart *et al.*, the chimeric receptor of Pestka *et al.* would not be expected to work in the yeast cells of Trueheart *et al.* without undue experimentation or testing.

Accordingly, reconsideration and withdrawal of the obviousness rejections of claims 1-6, 10, 14-16, 18 and 21-25 are requested.

#### ENTRY OF AMENDMENTS

The proposed amendments to claims 11, 15, 24 and 25 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings, do not add any new matter to the application and should place the application in condition for allowance. The amendment to claim 11 should be entered since it overcomes the rejection of claim 11. The addition of the element directed to measuring binding of a ligand to the chimeric receptor should be entered in claim 15 since it adopts suggestions of the Examiner and should overcome the rejection of claim 15. The proposed amendments to claims 24 and 25 should be entered since they comply with requirements as to form and adopt suggestions of the Examiner. Further, the amendments to each of claims 1, 15, 24 or 25 directed to a mammalian cell should be entered since they should remove the obviousness rejections and should not require a further search since the proposed amendments, *i.e.*, to mammalian cells, is a subset of eukaryotic cells that was

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previously searched. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested since they certainly removes issues for appeal.

### **CONCLUSION**

In view of the amendments and remarks presented herein, applicants respectfully submit that the claims define patentable subject matter. If questions should remain after consideration of the foregoing, the Examiner is kindly requested to contact applicants' attorney at the address or telephone number given herein.

Respectfully submitted,

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